IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Customer Number: 46320
	:	
Virinder BATRA, et al.	:	Confirmation Number: 6050
	:	
Application No.: 10/068,362	:	Group Art Unit: 2152
	:	
Filed: February 6, 2002	:	Examiner: A. Wildhalm
	:	
For: OBTAINING LOCATION INFORMATION USING A REJECTION MODEL		

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

    This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S

ANSWER dated August 31, 2007.

    The Examiner's response to Appellant's arguments submitted in the Appeal Brief of June

1, 2007, raises additional issues and underscores the factual and legal shortcomings in the

Examiner's rejection. In response, Appellants rely upon the arguments presented in the Appeal

Brief of June 1, 2007, and the arguments set forth below.

1   <u>Rejection under the 2nd paragraph of 35 U.S.C. § 112</u>

2   On page 3-7 of the Appeal Brief, Appellants addressed the Examiner's (2) separate

3 rejections under the second paragraph of 35 U.S.C. § 112. The Examiner's response to these

4 arguments is found in the paragraph spanning pages 10 and 11 of the Examiner's Answer. Of

5 particular note, the Examiner asserted the following:

> 6 Appellant's arguments are focused on the interpretation of location-based processing in light of
> 7 pages 1-4 of appellant's disclosure. This section provides examples in which restrooms,
> 8 restaurants, and weather forecasts are provided based upon the actual geographic location of the
> 9 mobile user. Although these examples are helpful, they are still examples and do not provide an
> 10 explicit definition of location-based processing. Therefore, the scope of the claimed invention
> 11 includes processing based on geographic location, spatial location, and network location.
> 12 Examiner has rather rejected these claims under 35 USC 112 second paragraph to point out the
> 13 difference in scope between appellant's specification, arguments, and claims. Describing specific
> 14 system components would help define the scope, as well as including in the claims more detail as
> 15 to which interpretation of location-based processing is intended.

16
17 Although not explicitly stated in a straight-forward manner, upon reviewing this passage, it

18 appears that the Examiner is asserting that while Appellants are interpreting "location based

19 processing" in one manner (i.e., processing based on geographic location of the entity requesting

20 the processing/service), the Examiner believes the term "location based processing" has a

21 broader scope (i.e., also including processing based on spatial location and network location,

22 presumably of the processor). Because of this allegedly broader scope, the Examiner reasons

23 that "the scope of the claims is not commensurate with appellant's disclosure."

24

25   This analysis, by the Examiner, fails on several levels. As claimed, location-based

26 services are provided by location-based processing. The phrase "location based services" is not

27 as ambiguous as made out by the Examiner. A search[1] of issued U.S. patents for the exact

28 phrase "location based service"[2] yielded 140 hits.[3] A quick review of the titles of these patents

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[1] The search was performed at http://patft.uspto.gov/netahtml/PTO/search-adv.htm.
[2] As described in http://en.wikipedia.org/wiki/Location-based_service:

1   yields the conclusion that these patents deal with mobile units that receive information pertinent

2   to the location of the mobile unit based upon the location of the mobile unit.

3

4   For example, the earliest issued patent is U.S. Patent No. 5,740,538, with an issue date of

5   April 14, 1998. In the Background of the Invention section, it is stated:

6   Some organizations provide services or information to a user based on the location of the
7   user. For purposes of this specification, these organizations are referred to collectively as "location
8   based services" or "services." For example, one location based service provides current weather
9   information to users over the telephone network. To provide the user with the appropriate weather
10   information, the service must know the location of the user. Typically, such services use the caller-
11   ID service provided by the telephone network to determine the location of the user. For example,
12   the area code and exchange of a telephone number can provide the service with the location of a
13   wireline telephone. Based on this location information, a service can give the user accurate
14   information on, for example, the current weather, location of a restaurant or other location based
15   service.
16
17 This description of "location based services," made approximately 6 years prior to Appellants'

18 description of "location based services" in the present patent application, is consonant with

19 Appellants' description of the same.

20

21   On the contrary, despite the Examiner's alternative readings of the scope of "location

22 based services," the Examiner has failed to establish any objective evidence that supports the

23 Examiner's position that the phrase "location-based service" encompasses processing based on

24 spatial location and network location, presumably of the processor. Moreover, as noted in the

25 paragraph spanning pages 8 and 9 of the Appeal Brief, the Examiner's construction of "location-

26 based" completely reads any many out of the term. All services are performed at a location.[4]

        Location-based services (LBS) (or LoCation Services, LCS) are services developed and
        distributed by wireless carriers and their partners which provide information specific to a location.
        The advantage is that mobile users don't have to manually specify ZIP codes or other location
        identifiers to use location-based services.
[3] A similar searched performed on Google, i.e., using the exact phrase "location based service," yields 258,000 hits.
[4] The "location" of any service being performed can be either broadly defined, such as a barber shop or a law office,
or more narrowly defined, such as Suite 110B or a particular server with a particular address on a network.

1   Thus, based upon the Examiner's interpretation all services are "location based." However, in

2   interpreting the phrase "location-based service" in this manner, the Examiner has impermissibly

3   read the term "location-based" out of this phrase. In this regard, ignoring a claim term

4   constitutes clear legal error. [5]

5

6   Rejection under 35 U.S.C. § 103 based upon Schwartz

7   On pages 7-12 of the Appeal Brief, Appellants presented several separate arguments as to

8   why one having ordinary skill in the art would not have arrived at the claimed invention based

9   upon Schwartz. Appellants first argument was that none of the passages within Schwartz cited

10   by the Examiner describe location-based processing. The Examiner's response to this is found

11   on page 11 of the Examiner's Answer. Of particular note, the Examiner asserted the following:

12   Although these examples are helpful, they are still examples and do not provide an explicit
13   definition of location-based processing. Examiner was attempting to aid in furthering prosecution
14   by <u>pointing out other interpretations of location-based processing that falls within the scope of the</u>
15   <u>claimed invention</u>. A URL request falls within this scope, as do GML and GPS supported
16   location-based processing. The URL request contains the address of a server and requests access
17   to information located at that specific server. Because there is no definition in appellant's
18   disclosure or the appealed claims, location-based processing is interpreted to mean the processing
19   of information relating to a location, e.g. a network address. Schwartz follows this interpretation.
20   (emphasis added)
21
22   These assertions have already been addressed above. Location-based processing/services have a

23   <u>very specific meaning</u> to those skilled in the art. The Examiner's analysis as to "other

24   interpretations of location-based processing," however, has <u>no factual support</u>. Although

25   Appellants recognize that in construing claims the Examiner is to give a particular term its

26   broadest, <u>reasonable</u> construction consistent with Appellants' specification, the Examiner's claim

27   construction is <u>not</u> reasonable when the Examiner's interpretation is both factually unsupported

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[5] <u>Uniroyal, Inc. v. Rudkin-Wiley Corp.</u>, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); <u>In re Miller</u>, 441 F.2d
689, 169 USPQ 597 (CCPA 1971); <u>In re Wilson</u>, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970).

1   and inconsistent with the ordinary and customary meaning attributed to the phrase "location-

2   based services."

3

4   Under the second paragraph of 35 U.S.C. § 112, the claims are to "particularly [point]

5   and distinctly [claim] the subject matter which the applicant regards as the invention." However,

6   Appellants question how this requirement can be met when the Examiner's claim construction

7   reads the distinctiveness out of the claim terms used by Appellants.

8

9   _____

10   On page 10 of the Appeal Brief, Appellants argued that a request for more information is

11   not a "rejection response," as claimed. The Examiner's presented a lengthy rebuttal on page 12

12   of the Examiner's Answer. Of note, the Examiner asserted:

13   Schwartz's response is a request for more information and is interpreted to be equivalent to a
14   rejection response because the original request lacked necessary information and could not be
15   completed as requested.
16
17   The error in the Examiner's analysis can be best described by analogy. When entering a website

18   that requires a ID/password, the website solely requesting the ID/password (e.g., after clicking

19   on a link to "Logon") does not constitute a "rejection response," given the ordinary and

20   customary meaning attached to that phrase. This is comparable to the disclosure of Schwartz.

21

22   However, if after submitting the ID/password, the response was "logon incorrect, please

23   e-mail address to have ID/password sent," such a occurrence would constitute a "rejection

24   response" and a request for more information. Upon reviewing the Examiner's cited passages

25   within Schwartz, Appellants are unable to find a comparable teaching to the claimed rejection

26   response.

1

2   The Examiner further asserted the following with regard to Appellants argument that the

3   Schwartz fails to teach request for "required location information." The Examiner responded as

4   follows:

> 5   And regarding appellant's argument that the request for more information taught by Schwartz is
> 6   not a request for the location of the pervasive computing device, examiner responds that the claim
> 7   states "a request for required location information." There is no explicit definition in appellant's
> 8   disclosure or within the claims that "required location information" is the location of the pervasive
> 9   computing device. The pervasive device sends the network requests for location-based processing,
> 10   however there is also nothing in the claim linking the location of the pervasive device with the
> 11   required location information.

12

13   The Examiner's response is notable, not for what is asserted, but for what is not asserted.

14   Specifically, although the Examiner asserts that there is no required definition for "required

15   location information," the Examiner omits, from this passage, an explanation as to why the

16   Examiner's interpretation of the phrase "required location information" is reasonable in light of

17   Appellants' specification.

18

19   _____

20   On pages 10-12 of the Appeal Brief, Appellants presented arguments as to the Examiner's

21   failure to teach the claimed "locating said required location information from within said stored

22   network request. The Examiner's response to this rejection is found in the paragraph spanning

23   pages 12 and 13 of the Examiner's Answer and reproduced, in part, below:

> 24   As to appellant's argument that Schwartz did not disclose fulfilling requests for additional
> 25   information with stored information and that one of ordinary skill in the art would not have been
> 26   motivated to do so based on Schwartz' teachings (appeal brief p. 10-12), examiner respectfully
> 27   disagrees. Schwartz described sending a request and in response to this request, receiving a request
> 28   for more information. The user then provides the additional information and the previous request
> 29   is updated, i.e. a new request is generated. This new request is then passed to a link server and
> 30   then either filled from information stored in the link server or the request is passed again to a
> 31   network server.

32

1   At the outset, Appellants note that the Examiner's assertion that "examiner respectfully

2   disagrees" misstates the Examiner's position. Referring to page 7 of the Third Office Action and

3   pages 5 and 6 of the Examiner's Answer, the Examiner has _revised_ the Examiner's previously-

4   stated position. Specifically, the Examiner is now only asserting that Schwartz teaches "locating

5   said required location information," whereas previously, the Examiner argued that Schwartz

6   teaches "locating said required location information from with said stored network request."

7

8   The Examiner further argued in the same paragraph the following

9   Examiner provided a 35 USC 103(a) rejection because Schwartz did not explicitly disclose
10   providing the requested additional information from a stored request. Schwartz disclosed fulfilling
11   other requests with stored information instead of forwarding those requests to another server.
12   Filling requests locally when possible reduces needless network traffic and conserves network
13   bandwidth. Therefore the capability to fulfill requests with stored information and the motivation
14   to do so was described. It would have been obvious to one of ordinary skill in the art at the time of
15   invention to fulfill requests for additional information with stored information and thereby reduce
16   needless network traffic.
17
18   Notwithstanding the Examiner's assertion that the "capability to fulfill requests with stored

19   information" is obvious, the Examiner has failed to explain the common sense rationale for

20   fulfilling the request for location information from information in the stored _network request_.

21   Based upon the Examiner's own analysis, the "location information" being supplied is from the

22   user (see column 17, lines 36-37), which is _not_ in the form of a network request.

23

24   Thus, the Examiner has not established that this location information being retrieved is

25   found in a network request. Thus, although it may be obvious retrieve location information from

26   stored information, the Examiner has not established that it is obvious to retrieve location

27   information stored in a network request. Moreover, for the Examiner to establish that the

28   location information is available to be retrieved from the network request, the Examiner also has

1   to establish that the network request is stored at the time the rejection response is received. This

2   factual finding, however, has not been made by the Examiner.

3

4   Appellants also note that the Examiner's asserted rationale is not supported by a logical

5   analysis. As asserted by the Examiner, Schwartz obtains the alleged "location information"

6   directly from the user. This alleged "location information" is required after the user drills down

7   from the entry portal (i.e., Fig. 7A) through various pages (i.e., Figs. 7B-7F) until the user arrives

8   at Fig. 7G, which requests that the user enter the name of the town upon which news is

9   requested. If Schwartz were to be modified, as suggested by the Examiner, so that the initial

10   request contains the additional information needed for the location-based processing, the initial

11   request would not only have to include the alleged "location information" (i.e., the name of the

12   town), but also all the other possible information needed to respond to a request. Based upon all

13   the possible permutations of information that could be entered in the various pages (i.e., Figs.

14   7B-7F), there could be hundreds, if not thousands of possible "information" that needs to be

15   included in the initial request in order to meet the Examiner's asserted benefit of "[reducing]

16   needless network traffic." To include all this information would be cumbersome, network

17   intensive, and require the user to make predictions, at the very beginning, as to what alleged

18   "location-based processing" the user wants to perform. Thus, the Examiner's obviousness

19   analysis fails to recognize the excessive burdens (which far outweigh the alleged benefit) placed

20   on both the user, software designer, and network if the Examiner's proposed modifications were

21   to be implemented.

22

23

1   Rejection under 35 U.S.C. § 103 based upon Kimoto in view of Liming

2   On pages 12-15 of the Appeal Brief, Appellants presented, among others, arguments as to

3   why Kimoto fails to teach "receiving a rejection response to said forwarded network request and

4   identifying in said rejection response a request for required location information." The

5   Examiner's response to these arguments is found in the paragraph spanning pages 13 and 14 of

6   the Examiner's Answer and reproduced below:

7   Examiner did not cite step D1 of figure 46 to teach a request for location-based processing. Figure
8   46 is a registration process in which additional location information is requested of the user.
9   When starting the registration process, a request to begin the registration process is inherently
10   included. A user sends position information and during the registration process, additional
11   information is requested. (emphasis added)
12

13   The Examiner's above-underlined inherency argument is newly presented, and Appellants submit

14   that the Examiner's reliance upon the doctrine of inherency to disclose this feature is misplaced.

15   Inherency may not be established by probabilities or possibilities. The mere fact that a certain

16   thing may result from a given set of circumstances is not sufficient to establish inherency.[6] To

17   establish inherency, the extrinsic evidence must make clear that the missing element must

18   necessarily be present in the thing described in the reference, and that the necessity of the

19   feature's presence would be so recognized by persons of ordinary skill.[7] Furthermore, reference

20   is made to ex parte Schricker,[8] in which the Honorable Board of Patent Appeals and

21   Interferences stated the following:

22   However, when an examiner relies on inherency, it is incumbent on the examiner to point to the
23   "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9
24   F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an
25   explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or
26   suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151
27   (CCPA 1981).

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[6] In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency
was based on what would result due to optimization of conditions, not what was necessarily present in the prior art);
In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).
[7] Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745, 49
USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir.
1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).
[8] 56 USPQ2d 1723, 1725 (BPAI 2000).

1
2 The Examiner did not discharge that burden of indicating where such a teaching appears in the

3 prior art. Thus, the Examiner has not established that this limitation is inherently disclosed by

4 Kimoto. Appellants also note that the Examiner has not addressed many of Appellants other

5 arguments regarding the proposed combination of Kimoto and Liming.

6
7
   For the reasons set forth in the Appeal Brief of June 1, 2007, and for those set forth

herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections

under 35 U.S.C. §§ 103, 112.

   To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is

hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to

such deposit account.

Date: October 31, 2007   Respectfully submitted,

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